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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,260

07/24/2003

Robert Greenberg

S202-USA

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01/21/2011

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EXAMINER

BLATT, ERIC D

ART UNIT

PAPER NUMBER

3734

NOTIFICATION DATE

DELIVERY MODE

01/21/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/627,260	<b>Applicant(s)</b> GREENBERG ET AL.	
	<b>Examiner</b> Eric Blatt	<b>Art Unit</b> 3734	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-2-2010 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 6, 8, 11, 20, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Shippert (US 5,507,807).

Shippert discloses a surgical tool capable of being used for implantation of an electrode array (Figures 3-6) comprising a frontally closed end portion 48 having a curved shape, the curved shape defining a rounded front exterior surface and a back interior surface opposite the rounded front exterior surface, a base portion 76 coupled to the back interior surface at a first location, and a top portion 24 coupled to the back

Art Unit: 3734

interior surface at a second location. The base portion 76 is coupled to the back interior surface of the end portion 48 by means of coupling means 72, 82. A point near the distal end of coupling means 72, 82 may be interpreted to comprise the claimed first location. The distance between the first location and the second location defines an open space capable of receiving and protecting an electrode array. The open space is open toward the proximal direction toward an end opposite from the frontally closed end portion. (See, for example, Figure 4 wherein a plunger is shown entering the proximal open end of the open space opposite the frontally closed end portion.) The top portion 24 and the base portion are movable with respect to each other to gently grip and hold an electrode array. The open space is between the base portion and the top portion, and in an operating condition, the base portion is substantially parallel to the top portion. The open space defines a lateral opening of the surgical tool through which an implant may be released. (Figure 6)

Regarding claim 5, the top portion and base portions have portions on their outer surfaces that are curved and portions on their inner surfaces that are substantially flat.

Regarding claim 6, there is a keeper 88 connected to the base portion 76 to limit travel of the top portion 24.

Regarding claim 20, the base portion 76 is concave in one dimension and convex in another while the top portion 24 is convex in two dimensions. (Figure 3)

Regarding claim 24, the electrode array is functionally recited and is not considered to be positively claimed. Shippert discloses a first operating condition (when contact wedge 64 is located proximally as seen in Figure 4) for allowing retention of an

Art Unit: 3734

electrode array and a second operating condition (when contact wedge 64 is being advanced as seen in Figure 6) for allowing release of an electrode array through the lateral opening. In both operating conditions, the distance between the base portion and the top portion is controlled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shippert (US 5,507,807).

Regarding claim 2, as disclosed in Shippert, the tool must be disassembled in order to load an implant 40 between the top and base portions. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a hinge between the front end portion and the top portion so that an implant could be easily loaded into the delivery chamber without disassembling the device.

Regarding claim 7, Shippert discloses tracks 72a and 72b in the top portion that meet guides 82a and 82b in the base portion to latch the base and top portions together. It would have been obvious provide the tracks on the base portion and the guides on the top portion since such a modification would merely constitute a reversal of parts. The tracks comprise notches.

Regarding claims 9 and 10, it would have been obvious to one of ordinary skill in the art to fashion the tool of Shippert from ABS or stainless steel since it has been held that selecting a material known to be suitable for an intended purpose merely requires ordinary skill in the art.

Claims 4, 12-19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shippert (US 5,507,807) in view of Hughes (US 6,579,256).

Shippert teaches all elements of claims 4, 12-19, 22, and 26 except for the device being curved to approximate the radius of an eye and that the tool being used to deliver an electrode array into an orbital socket. Hughes teaches a similar delivery apparatus wherein the device is curved to approximate the radius of an eye, and teaches using said apparatus for delivery an electrode array into an orbital socket. (Figures 2-12 and Col. 4, Lines 33-37) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus and method of Shippert by curving the top and base portions to approximate the radius of an eye and using said the tool for delivering an electrode array into an orbital socket in order to restore a degree of vision to a patient as taught by Hughes.

Specifically regarding claim 17, Shippert discloses that the top and base portions slide relative to one another to allow an implant to be placed therebetween. It would have been obvious to one of ordinary skill in the art at the time of the invention to instead hingedly couple the top and base portions together since this would be a

Art Unit: 3734

functionally equivalent mechanism for allowing access to the chamber between the top and base portions.

### ***Response to Arguments***

Applicant's arguments filed 11-2-2010 have been fully considered but they are not persuasive.

Applicant argues, "Nowhere in Shippert is there a top and a base movable with respect to each other," submitting the plunger 28 is the only movable part in Shippert. Examiner disagrees with this characterization. Element 24 comprises a top as claimed and element 76 comprises a base as claimed. These elements are movable relative to one another as clearly depicted in at least Figures 4 and 6. With regard to the recitation that the open space between the top and base portions is open toward an end opposite from the frontally closed end portion, Shippert discloses an open space 32 between the top and base portions wherein said open space is open in the proximal direction opposite from the frontally closed end portion. An array cable could be inserted into the open space 32 through the proximal open end before inserting a plunger into the open space 32.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

Art Unit: 3734

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. B./  
Examiner, Art Unit 3734

/TODD E. MANAHAN/  
Supervisory Patent Examiner, Art Unit 3776